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| 09/693,288 | 10/20/2000 | Dean F. Jerding | A-6686 | 8077 |

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| EXAMINER |
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BELIVEAU, SCOTT E

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| ART UNIT | PAPER NUMBER |
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2614

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,288

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 83-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 83-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 83-107 of this application. While the provisional application discloses the general concept of facilitating the extension of a rental, the examiner cannot find support for the claimed limitation for "receiving by the STT a first user input enabling the user to extend the access duration from the first value to a second value, the second value specified by the user".

2. Applicant's claim for domestic priority to US App No. 09/590,520 under 35 U.S.C. 120 is acknowledged. However, the application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 83-107 of this application. As aforementioned, the examiner cannot find support for the claimed limitation for "receiving by the STT a first user input enabling the user to extend the access duration from the first value to a second value, the second value specified by the user". Accordingly, the instant application shall be evaluated on the basis of its filing date of 20 October 2000.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation of claims 83 and 96 for "receiving by the STT a first user input enabling the user to extend the access duration

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from the first value to a second value, the second value specified by the user” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Response to Arguments

4. Applicant's remarks with respect to claims 41-58 and 71-82 have been considered but are moot as all of the previously presented claims have been cancelled. A new ground(s) of rejection is presented as follows.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 83-107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the limitation for “receiving by the STT a first user input enabling the user to extend the access duration from the first value to a second value, the second value specified by the user” is not enabled. As illustrated in Figure 8 and further described in the application, it is the examiner’s understanding that the user in connection with renting a movie specifies initial or “first value” of the access duration. Subsequently, the user is operable to specify a “second value” which specifies the amount by which the original access duration is to be extended. For example, if the user initially specified an access duration of 2 hours and then designates an extension of 1 hour then the access duration would change from 2 hours to 3 hours. However, as claimed, the user designates a first value of the access duration of 2 hours and then designates a second value or 1 hour to which the access duration is changed to 1 hour. Such would appear to defeat the purpose of a rental extension. Accordingly, it is the examiner’s opinion that an amendment to the claim language along the lines of “receiving by the STT a first user input enabling the user to extend the access duration from the first value to a second value, based upon a third [second] value specified

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by the user” wherein the third value refers to the amount of extension would be enabled by the specification as originally filled.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 83-85, 87, 91, 96-98, and 100 are rejected under 35 U.S.C. 102(b) as being anticipated by Lett et al. (US Pat No. 5,592,551).

In consideration of claims 83 and 96, Figure 1 of the Lett et al. reference illustrates a system and method for providing a “media service to a user” via an “interactive media services client” or “STT” [14] to a “programmable media services device” [10/12]. As shown in Figure 3, the “STT” [14] comprises “at least one memory having stored thereon program code” [134] and “at least one processor that is programmed by at least the program code” [128] (Col 9, Lines 1-3 and 43-46) so as to implement the method as claimed. In particular, the “STT . . . [receives] a movie identification identifying a movie” (ex. Terminator 2) whereupon the “responsive to receiving the movie identification”, the user “assigns an access duration having a first value to the movie” corresponding to the rental period (ex. 1 day) such that the “user [is subsequently enabled] by the STT . . . to access the movie video presentation during the access duration” (Figures 13-17A; Col 12, Line 28 – Col 13, Line 3; Col 16, Lines 38-59; Col 17, Lines 9-61). Prior to the start of the presentation,

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the “STT” [14] may receive a command so as to cancel the pending purchase (Figure 20; Col 17, Lines 41-47). Accordingly, the “STT” [14] implicitly may “receive . . . a first user input enabling the user to extend the access duration from the first value to a second value, the second value specified by the user” (ex. the user changes their mind and decides to rent the previously designated Terminator 2 for a longer period such as 3 days or 1 week versus the original period of 1 day) whereupon the “STT” [14] “enables . . . the user to access the movie during the extend access duration responsive to receiving the first user input” in a manner similar to the original purchase.

Claims 84 and 97 are rejected wherein the system “provides the user with pricing information related to the extended access duration” (Figure 13).

Claims 85 and 98 are rejected in view of Figures 13-17A wherein the “STT” [14] “provides . . . the user with a selectable option . . . being configured to enable the user to extend the access duration from the first value to the second value” (ex. change the original purchase terms from 1 day to more than 1 day) in response to “receiving by the STT the first user input corresponding to the selectable option” (Figure 13).

Claims 87 and 100 are similarly rejected in view of Figures 13-17A wherein the “STT” [14] “provides . . . the user with a plurality of selectable options” (ex. 3 days or 1 week) corresponding to different time periods for which to extend the original purchase terms (ex. 1 day) wherein “each of the selectable options [is] configured to enable the user to extend the access duration from the first value to a third value” in response to “receiving by the STT the first user input corresponding to one of the selectable options” (Figure 13). Given that the

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same input (ex. first input) is utilized to select both the “second value” and the “third value” it is presumed that the two values must be same for the purposes of enablement.

Claim 91 is rejected in view of Figure 13 wherein the system “charges the user a first price in connection with the access duration” (ex. \$2.99 for 1 day) and “charges the user a second price in connection with the extended access duration” (ex. \$3.99 for 3 days) wherein “the first price is different from the second price” as shown.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
February 5, 2005



JOHN MILLER
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